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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,569	07/22/2003	Akiko Miyano	Q76408	6558
23373	7590	05/10/2006		
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037				
			EXAMINER DESAI, ANISH P	
			ART UNIT 1771	PAPER NUMBER

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/623,569

Applicant(s)

MIYANO ET AL.

Examiner

Anish Desai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/24/06</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

The applicant's arguments in response to the Office action dated 09/27/05 have been fully considered.

1. The obviousness type double patenting rejection over Ho et al. (US 5,468,532) taken individually or collectively is withdrawn in view of the present amendments and response (see pages 2-6 of 02/24/06 amendment). However, upon further consideration a new ground of rejection is made over Ho et al. (US 5,468,532) in view of Mueller et al. (US 6,180,228B1).
2. The obviousness-type double patenting rejection is not withdrawn.

### ***Information Disclosure Statement (IDS)***

3. In the IDS submitted on 02/24/06, the applicant has provided a European search report (ESR) citing JP 2002-235053 A (abstract) as "X" reference. The examiner has reviewed aforementioned reference but not agreed with the citation of the ESR because the JP 2002-235053 A does not teach or suggest substrate comprising a white layer, a layer or color other than white and black, and a black layer which are superposed in this order as claimed by the applicant.

### ***Terminal Disclaimer***

4. The terminal disclaimer filed on 02/24/06 disclaiming the terminal portion of any patent granted on this application, which would extend beyond the expiration date of 11/041,394 has been reviewed but not accepted. An attorney or agent, not of record, is not authorized to sign a terminal disclaimer in the capacity as an attorney or agent

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acting in a representative capacity as provided by 37 CFR 1.34 (a). See 37 CFR 1.321(b) and/or (c).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ho et al. (US 5,468,532) in view of Mueller et al. (US 6,180,228B1).

Ho teaches a multilayer graphic article comprising a substrate, at least one color layer disposed on the substrate, and a protective surface layer that overlies the substrate and the color layer (see Abstract). The multilayer graphic article may be applied to a wide variety of substrates including motor vehicles, marine craft, snowmobiles, sign faces and the like (Column 2, lines 35-37). Further the multilayer graphic article of Ho comprises a protective film layer 18, a substrate 16, a first color layer 12, a second color layer 14, an adhesive layer 20, and a removable liner 22 as shown in Figure 2. Moreover, Ho teaches that materials for forming substrate can be varied as polymeric film, an adhesive, or a temporary removable liner (Column 2, lines 11-13). The adhesive used in the invention of Ho is a pressure sensitive adhesive (Column 6, lines 7-10). Additionally, Ho teaches that there can be more than one color layer present in the graphic article (Column 3, lines 18-22), which reads on the

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substrate comprising colored layers as claimed in claim 1. Further Ho teaches that the color layer comprises color agents including black, white, and metallic such as aluminum flakes (Column 4, lines 55-58). Ho is silent as to teaching of a pressure sensitive adhesive disposed on the both sides of the substrate. However, Muller teaches an outdoor advertising system or display system including a multilayer graphic article. The multilayer graphic article of Muller comprises an image layer 24 that is formed of one or more color layers and a pressure sensitive adhesive layer 38 on one surface of the image layer 24 (Figure 1). Further the multilayer graphic article of Muller comprises an image protective layer 32 that is bonded to the image layer 24 via the pressure sensitive adhesive layer 38 (Figure 1). Thus, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use a pressure sensitive adhesive layer 16 as a substrate as shown in Figure 2 of Ho, motivated by the desire to bond the protective film 18 to the second color layer 14. Note that, the adhesive layers 16 and 20 of Ho with color layers in between the said adhesive layers read on the claimed double-sided pressure sensitive adhesive tape. Further, the color layers of Ho read on the tape substrate as claimed in claim 9.

With respect to claims 1 and 9, although Ho does not explicitly teach colored layers comprising a white layer, a layer of color other than white and black, and a black layer which are superposed in this order, however in absence of showing criticality of the order of the color layers as claimed, it would have been obvious to one having ordinary skill in the art at the time the invention was made to choose the color layer

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comprising a white layer, a layer of color other than white or black, and a black layer, motivated by the desire to enhance the aesthetics of the graphic article.

6. Claims 1 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller et al. (US 6,180,228B1).

Muller teaches an outdoor advertising system or display system including a multilayer graphic article. The multilayer graphic article of Muller comprises a base layer 16, which can be colored (Column 5, lines 7-9 and Figure 1), a pressure sensitive adhesive layer 22 on one surface of the base layer 16 (Column 5, lines 48-42 and lines 60-61, Figure 1), an image layer 24 on one surface of the base layer 16, wherein the image layer 24 is formed of one or more color layers (Column 6, lines 30-32 and Figure 1), and a pressure sensitive adhesive layer 38 formed on one surface of the image layer 24 (Column 7, lines 26-27 and line 35-38). The colored base layer 16 and the image layer 24 formed of more than one color layer of Muller reads on the substrate comprising colored layers as claimed in claim 1. The colored base layer 16 and the image layer 24 formed of one or more color layers of Muller reads on the claimed tape substrate as claimed in claim 9. Further the adhesive layers 22 and 38 along with the colored base layer 16 and the image layer 24 read on the claimed double-sided pressure sensitive adhesive tape.

Muller does not explicitly teach colored layers comprising a white layer, a layer of color other than white and black, and a black layer which are superposed in this order, however in absence of showing criticality of the order of the color layers as claimed, it would have been obvious to one having ordinary skill in the art at the time the invention

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was made to choose the color layer comprising a white layer, a layer of color other than white or black, and a black layer in the invention of Muller, motivated by the desire to enhance the aesthetics of the multilayer graphic article of Muller.

### ***Response to Arguments***

7. Applicant's arguments with respect to claims 1 and 9 have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-9 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-4,6, and 16-18 of copending Application No. 11/041,394 substantially as set forth in 09/27/05 Office action.

**Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anish Desai whose telephone number is 571-272-6467. The examiner can normally be reached on Monday-Friday, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

APD

Hai Vo

**HAI VO**  
**PRIMARY EXAMINER**